

## REMARKS

Favorable reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks are respectfully requested.

In the Office Action, various claims were objected to under 35 U.S.C. §112. Although Applicants do not acquiesce in the objection, claims 41, 83 and 121 have been amended which should render the objection moot.

In the Office Action, claims 41-45, 52, 56-57, 59-64, 69-70, 81-87, 94-95, 99-100, 102-107, 110, 112, 114-116, and 118-125 were rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,474,095 to Allen. All of the above claims, however, require the presence of “treated discrete areas” on the paper web that comprise “a film-forming composition”. In stark contrast, Allen does not disclose or suggest creating treated discrete areas on a paper web for a smoking article that comprise a film-forming composition. Instead, Allen is directed to a “nonlaminated” paper that has crossdirectional regions of “increased basis weight.” More particularly, Allen discloses crossdirectional regions of increased basis weight that are achieved by providing a paper with localized regions of either 1) increased thickness and/or 2) increased density by depositing on the paper web additional papermaking materials such as a second quantity of pulp or a filler material. In contrast to the currently pending claims, the pulp and/or filler materials applied to the paper web in Allen to form the crossdirectional regions do not comprise a “film-forming composition”.

In fact, Allen teaches away from producing treated discrete areas on a paper web that comprise a film-forming composition. For example, in column 1 at line 59, Allen describes various previous attempts to decrease the burn rate of wrapping materials for smoking articles by using a burn retardant. In this regard, Allen states that such burn retardants can contribute undesirable flavors to the smoking article upon combustion. Thus, Allen is directed to increasing the basis weight of the paper using papermaking materials in order to avoid having to use other chemicals that act as burn retardants. In this regard, Allen repeatedly teaches that the primary object of his invention is to produce a “nonlaminated” paper having either an increased thickness or increased density.

Allen does mention in column 5 that the paper may include relatively minor amounts of sodium carboxymethylcellulose, which is a film former. The sodium

carboxymethylcellulose, however, does not form treated discrete areas on the web and is merely present in order to improve ash cohesiveness and reduce sidestream smoke.

In view of the above, Applicants submit that the currently pending claims are not anticipated or rendered obvious by Allen.

In the Office Action, all of the claims were also rejected under 35 U.S.C. §103 in view of a 4-way combination of Peterson, Hampel '755, Hampel '860, and further in view of Allen. As stated above, however, Allen is directed to producing crossdirectional regions by increasing the basis weight of the paper as a way to avoid having to apply burn retardants to the paper. In contrast, Peterson is directed to producing discrete areas of reduced permeability by treating the paper with a film-forming solution. Peterson minimizes discernible changes in smoke delivery and taste to a smoker by, in one embodiment, producing ramp-shaped bands. Since Allen teaches away from using burn retardants, Applicants submit that one skilled in the art having common sense at the time of the invention would not have reasonably considered combining Peterson with Allen as asserted in the Office Action. For example, due to the completely different materials used in forming the crossdirectional bands in Allen and in Peterson, one skilled in the art would not have reasonably considered incorporating the band parameters of Allen into the disclosure of Peterson, especially since Peterson teaches a band spacing of between 5 and 10 mm and states in Example 8 that a 10 mm band spacing "was too great to prevent an ignition."

As explained in previous responses, Peterson also teaches away from a wrapping paper having a permeability greater than about 60 Coresta as required in all of the currently pending claims. In column 2 and in column 9, Peterson states that "if the change in permeability between the treated areas and untreated areas of the cigarette is relatively great, the smoker will discern a difference in taste and smoke delivery." In the Office Action, the Examiner indicated that Peterson provides no frame of reference for gauging the above "relatively great" change in permeability between treated and untreated regions. The Examiner also indicated that Applicants have presented no evidence to suggest what threshold change in relative permeability constitutes a "relatively great" change. In response, the Examiner's attention is directed to the Declaration previously submitted under 37 CFR 1.132 signed by Dr. Richard Peterson.

As stated in the Declaration, Dr. Peterson has a Bachelor of Science in Chemical Engineering and a Masters of Science and PhD degrees in Paper Science and Technology. Dr. Peterson is now retired but previously had over 31 years of experience in the papermaking industry. In his Declaration, Dr. Peterson states that there is an unmistakable teaching in Peterson to minimize permeability differences between the treated and the untreated areas in order to minimize discernible changes in smoke delivery and taste to the smoker. When viewing his prior patent in its entirety, Dr. Peterson opined that one skilled in the art would not have looked to incorporating wrappers having a permeability of greater than about 60 Coresta into the wrapper constructions disclosed in Peterson. Thus, Applicants submit that they have offered ample evidence into the record that indicates what a "relatively great" change in permeability means in the context of Peterson.

In fact, Allen itself indicates in column 4 that conventional wrapping materials have a permeability from 25 to 60 Coresta. Wrappers having a permeability of greater than about 60 Coresta are not "normally found" in smoking articles as stated in Allen which is further evidence to show the non-obvious nature of the articles defined by the currently pending claims.

In summary, Applicants submit that the currently pending application is in complete condition for allowance and favorable action is respectfully requested. Should any issues remain after consideration of this response, however, then Examiner Lazorcik is invited and encouraged to telephone the undersigned at his convenience in the hopes of resolving any such outstanding issues.

Respectfully submitted,

DORITY & MANNING, P.A.



Timothy A. Cassidy  
Reg. No. 38,024  
P.O. Box 1449  
Greenville, SC 29602  
(864) 271-1592  
(864) 233-7342

June 23, 2010

Date